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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,016	01/21/2004	Takako Hirose	32911US1	3995
116 7590 10/12/2007 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER HU, JINSONG	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/762,016

Applicant(s)

HIROSE ET AL.

Examiner

Jinsong Hu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-6 are presented for examination. Claims 1-6 have been amended.
2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The claim language in the following claims is not clearly understood.

i. As per claim 1, applicant first claims "a notification which the server unit transmits to the client system on the server unit's own initiative" in the preamble, it directs to the server notify a user once a mail arrive, but in the following part of the claims, there is no any step indicates the server will initially sending a notification to user first without user request. Furthermore, in the claims, the server only has two functions, one is storing the message, another function is transmitting the message based on user's request. There is no any limitation directs to notification function. Additionally, applicant never clarifies the relationship between "the succeeding message" and "the message" [i.e., they are the different portions of the same message or they are totally different messages].

### ***Double Patenting***

3. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6 of copending Application

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No. 09/622,656 (hereinafter as 656'). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claimed a client system requesting delivering the message stored on the server system when the client system received a notification from the server system, and it is obvious to a person in the art that "notification" in this application is the same meaning of "a message start notification" in application 656'.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (US 6,314,454).

6. As per claim 1, Wang teaches the invention substantially as claimed including a message delivery system having a client system acquiring a delivery message from a server unit by requesting to transmit the delivery message in the server unit in

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compliance with a notification which the server unit transmits to the client system on the server unit's own initiative [col. 6, lines 45-55; col. 7, lines 17-20],

wherein the client system includes a received message portion which stores a delivery message information received from the server unit [col. 6, line 61 – col. 7, line 11], and an instruction and message acquisition requesting portion which informs the server unit of a succeeding message acquiring request if a succeeding message is present [col. 7 lines 14-24] and a process instructing request for the delivery message whose reception is completed when reception of the delivery message from the server unit is completed [col. 6, lines 55-58]; and

wherein the server unit includes: a delivery message storing portion which stores the delivery message to be transmitted to the client system, and message processing portion which transmits a succeeding message stored in the delivery message storing means to the client system in compliance with a request from the client system [col. 6, lines 45-55] and processes the delivery message whose reception is completed [col. 6, lines 55-60].

6. As per claim 2, Wang teaches the message processing means deletes the delivery message, which is informed by the client system and whose reception is completed, from the delivery message storing means in compliance with an instruction from the client system [col. 6, lines 55-60].

7. As per claim 3, Wang teaches the server unit holds the delivery message stored in the delivery message storing means until its deletion is instructed by the client system, and then transmits the same delivery message once again when it receives an acquiring request from the client system [col. 7, lines 25-26].

8. As per claim 4, Wang teaches the server unit further includes a processed message storing means for storing the messages delivered to the client system, and wherein, by instructing to move from the delivery message storing means of the server unit as the process for the delivery message whose reception is completed, the message processing means moves the delivery message, which is informed by the client system and whose reception is completed, from the delivery message storing means to the processed message storing means in compliance with an instruction from the client system [col. 7, lines 25-26 & 31-39].

9. As per claim 5, Wang teaches the server unit holds the delivery message stored in the delivery message storing means until its movement is instructed by the client system, and then transmits the same delivery message once again when it receives an acquiring request from the client system [col. 7, lines 25-26].

10. As per claim 6, Wang teaches a message instruction requesting means for informing the server unit of only a process instruction request for the delivery message

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whose reception is completed when there is no succeeding message [col. 7, lines 23-25].

### ***Conclusion***

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (571) 272-3065. The examiner can normally be reached on 8:00 AM - 5:30 PM.

NATHAN FLYNN  
SUPERVISORY/PATENT EXAMINER

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinsong Hu

September 11, 2007